

DETAILED ACTION

Response to Arguments

Applicant's arguments filed on 17 March 2008 have been fully considered but they are not persuasive.

The examiner acknowledges applicant's amendments to the claims, but does not find them to include allowable subject matter. Applicant has merely amended the independent claims to include dependent claims that were previously rejected in view of the prior art. For example, independent claim 1 has been amended to include the limitations found in originally filed claims 2, 5, 6, 8-11, 13, 21, and 22, which have now been cancelled. The other independent claims have been similarly amended. Because the subject matter that has been included into the independent claims was previously rejected in view of the prior art, the examiner finds that the applicant has failed to further define the invention over the prior art, and therefore the previous grounds for rejection still apply.

Additionally, applicant's amendments to claim 30 fail to properly claim statutory subject matter. Applicant has amended claim 30 to recite "one or more computer-readable signal-bearing media that comprise one or more recordable data storage media". Per the original grounds of rejection [prior office action, pp. 2], the examiner acknowledges that applicant's specification teaches a computer-readable signal-bearing media (which may include non-statutory carrier signals; see pp. 10 of applicant's specification) and a recordable data storage medium. The recordable data storage medium (representing an article of manufacture) is statutory, while the compute-readable signal-bearing medium (which includes carrier signals as part of its definition) is not. As such, applicant's amendment does not to clarify the issue, since the claim now recites one or more computer-readable signal bearing media that comprise one or more recordable data storage media. In other words, applicant has claimed non-statutory

computer-readable signal-bearing media that may be composed of an unspecified number of statutory recordable data storage media. This leaves open the possibility that the computer-readable signal-bearing media may be comprised of a mixture of recordable data storage media and non-statutory media such as carrier signals, since the open-ended nature of the "one or more" language could be read as "a plurality of computer-readable signal-bearing media comprised of one recordable data storage medium", for example.

Since applicant has specifically defined computer-readable signal-bearing media as including non-statutory carrier signals, any claim that recites computer-readable signal-bearing media must inherently be considered non-statutory. On the other hand, since a recordable data storage medium has been established as comprising statutory subject matter, any claim that recites a recordable data storage medium without reciting a computer-readable signal-bearing medium would be considered statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites "instructions ***in the one or more media*** for invoking a graphical user interface" in line 4. There is insufficient antecedent basis for this limitation in the claims. Applicant has previously recited "one or more computer-readable signal-bearing media" and

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"one or more recordable data storage media". The limitation in line 4 does not make it clear which media is being referenced.

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Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 30-33, the claimed invention is directed towards an article comprised solely of a computer-readable signal-bearing media. Applicant's specification is unclear in its description as to what constitutes a computer-readable signal-bearing media. At one point, the specification defines such media as being comprised of data storage media [pp. 9, paragraph 28], which would constitute statutory subject matter in the form of an article of manufacture that stores data. However, the same paragraph goes on to describe such media as modulated carrier signals transmitted over a network [pp. 10, paragraph 28]. Since the specification includes carrier signals in the description of computer-readable signal-bearing media, and since carrier signals cannot properly be classified as a process, machine, article of manufacture, or composition of matter, claims 30-33 are directed towards non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 7, 8, 12, 14-20, 23, 26, 27, 29, 30, 33, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bramely, Jr., U.S. Patent No. 6,889,340 B1, in view of Nice (DOS Start v.1.9b, readme.txt, retrieved from <http://www.icdc.com/~dnice/dosstart.zip>).

Regarding claim 1, Bramely teaches an apparatus comprising a pre-boot operating environment [EFI, col. 1, lines 62-67] used for one or more file management procedures employable [col. 1, line 67 to col. 2, line, EFI provides DOS functionality] with a command line interface [col. 2, line 4, EFI provides a command shell].

Bramely does not teach that the pre-boot operating environment uses a GUI.

Nice teaches a GUI that allows a user to carry out DOS functions such as launching programs and managing files [page 2, first line].

It would have been obvious to one of ordinary skill in the art to combine the teachings of Bramely with Nice by modifying the EFI shell of Bramely to provide a GUI to carry out the DOS functions, as taught by Nice. GUIs are well-known in the art for providing significant advantages over a command line interface. Nice teaches that the GUI implementation of DOS provides a number of powerful and useful features that are not available to a standard DOS command line [page 2]. Since Bramely teaches that the EFI environment provides a command shell for carrying out DOS functions, and since Nice teaches a GUI for carrying out DOS functions that is more powerful and user-friendly than a standard command line, it would have been obvious to one of ordinary skill in the art to modify Bramely according to the teachings of Nice in order to realize the disclosed advantages.

Nice and Bramely also teach:

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- that the GUI allows input from the user to cause selection and execution of file management procedures [Nice, pp. 2, File Manager],
- that the GUI communicates with one or more file storage components (specifically, since the GUI implements DOS functions, communications with a file storage component is inherent),
- that the file contents of the file storage components are readable by EFI (since EFI implements DOS functions, the ability of EFI to read file contents is inherent),
- that the pre-boot environment provides file management procedures [Bramely, col. 1, line 67 to col. 2, line, EFI provides DOS functionality],
- that the GUI sends requests to the pre-boot operating environment and file storage components (specifically, Nice teaches that DosStart is a GUI for DOS, and thus assumes underlying DOS command line functionality, while Bramely teaches that EFI provides this DOS command line functionality),
- that the pre-boot environment is EFI.

Regarding claim 3, it would have been obvious to use a hotkey to carry out the file management functions, as keyboard shortcuts are well-known in the art.

Regarding claim 4, Nice teaches that the user input of claim 2 is a menu item [pp. 2, DOS menu items].

Regarding claims 7-9, it would have been obvious to one of ordinary skill in the art to use a FAT file system for the combination of Bramely/Nice, since the FAT file system was designed to be used with DOS.

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Regarding claim 12, 13, and 16-19, Nice teaches that the GUI displays a list of currently available procedures, and allows the GUI to navigate through the files [pp. 5-11, screen shots], and also that the GUI is comprised of a shell with graphics and text.

Regarding claim 14, Nice teaches that the GUI employs file management procedures to manipulate and execute files [program overview, DosStart manages files and launches programs [readme, pp. 2].

Regarding claim 15, Bramely teaches running diagnostic programs in the pre-boot environment [Fig. 3, step 25].

Regarding claims 23, 26, 27, 29, 30, 33, 34, and 37, Bramely/Nice teaches the apparatus of claims 1, 3, 4, 7, 8, 12, and 14-20, and also the apparatus of claims 34 and 37, the method of claims 23, 26, 27, and 29 which is carried out by the claimed apparatus, and the article with instructions for carrying out the claimed method. Nice also teaches that the GUI may be invoked from the command line interface [readme, pp. 1, "Type DOSSTART to start DosStart at the DOS prompt."].

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JI H. BAE whose telephone number is (571)272-7181. The examiner can normally be reached on Monday-Friday, 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JI H. BAE/
Examiner, Art Unit 2115
U.S. Patent and Trademark Office
571-272-7181
ji.bae@uspto.gov

/Thomas Lee/
Supervisory Patent Examiner, Art Unit 2115